

Remarks

Claims 1-8 and 10-14 are pending in the current application. (Note that the claims as originally filed contain multiple claim misnumberings. Claim number 9 was omitted and Claim numbers 13 and 14 were repeated. In the amendment filed 5/5/03, the second set of Claim numbers 13 and 14 were canceled. Thus, Claims 1-8 and 10-14 are pending in the current application.) Claim 6 has been canceled. Subject matter from Claim 6 has been incorporated into amended Claim 1.

35 U.S.C. 103 Rejections

The subject matter of Claim 6, now amended Claim 1, was rejected under 35 U.S.C. 103(a) as being unpatentable over Berney et al. (U.S. Pat. No. 5,703,395) in view of further remark.

The Office Action recites “Although Berney et al. do not specifically teach the embedding of a voltage regulator, Berney et al. do mention (column 5, line 32) that auxiliary chip 20 can be a control circuit and voltage regulator are inherently a control circuit and this disclosure make claim 6 obvious over Berney et al.”

The Office Action is improperly equating inherency and obviousness. The CCPA, in *In re Spormann*, 53 CCPA 1375, 1380, 363 F.2d 444, 448, 150 USPQ 449, 452 (1966) stated that “the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.” Arguments made on inherent properties cannot stand when there is no supporting teaching in the prior art. The obviousness

rejection is improper because the Office Action indicates that specific features of the application, although not shown in the prior art, are inherent.

Accordingly, for at least the foregoing reasons, Berney et al. and the further remarks, whether taken alone or in combination, fail to disclose or suggest the limitations of Claim 1. The rejection of Claim 1 is thus unsupported, and must be withdrawn. Claims 2-5 and 7-8, and 10-14 depend from allowable Claim 1 and are allowable for at least this reason.

Conclusion

For the foregoing reasons, it is submitted that the application is in condition for allowance, and indication of allowance by the Examiner is respectfully requested. If the Examiner has any questions concerning this application, he or she is requested to telephone the undersigned at the telephone number shown below as soon as possible. If any fee insufficiency or overpayment is found, please charge any insufficiency or credit any overpayment to Deposit Account No. 02-2666.

Respectfully submitted,

Intel Corporation

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